

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re patent application:

Appl. No.	:	10/736,998	) Examiner: Wu, R.
Applicant	:	Mark Bresnan, et al.	
Filed	:	December 16, 2003	
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**PRE-APPEAL BRIEF CONFERENCE REQUEST**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Applicants request this pre-appeal review to consider the Examiner's rejections of claims 1-3, 6-25, 27-32, 35-53 and 55-57 in a Final Office Action dated December 12, 2008. A Notice of Appeal is filed herewith.

**Non-entry of Amendments**

In the February 25 office action the Examiner declined to enter the Amendments because they did not place the application in better form for appeal. On the contrary, however, the Amendments that were requested were solely to eliminate claims and to correct a typographical error by inserting a correction that had previously been suggested by the Examiner. Under the applicable regulations, these amendments should be entered. See 37 C.F.R. 1.116 (b)(1) ("An amendment may be made canceling claims or complying with any requirement of form expressly set forth in a previous office action."; MPEP 714.12).

With regard to the eliminated claims, claims 7 and 8 had previously depended from claim 6. In the amendment claim 6 was cancelled and the subject matter of claim 6 was added to those dependent claims. Nothing in the scope of claims 7 and 8 was

changed. Similarly, claims 36 and 37 were amended to include the subject matter of claim 35, from which they had depended, and claim 35 was cancelled. Thus, the effect was to cancel two claims (6 and 35), which need not be addressed now on appeal. Clearly this amendment, that does not touch the scope or merits of the claims, is within the realm of simplifying issues, as expressly recognized in the regulations.

With regard to claim 30, Applicants added the word "not" to the claim where it had inadvertently been omitted. This error was identified by the Examiner in the December 12, 2008 Office Action in making a §112 rejection. However, the Examiner recognized that the correct solution was to add the word "not," so that the claim was interpreted to mean "a rule whether messages that include particular marketing content may not be consolidated" for purposes of examination. See Para. 10, December 12, 2008 Office Action. Now the Examiner refuses to enter the very amendment that was suggested during that Office Action. This results in an incorrect view of 37 C.F.R. 1.116.

For these reasons it is requested that the After-Final amendments be entered. These amendments require zero additional substantive consideration, and are clearly the type of simplifying amendments that are permitted (and encouraged) under the rules.

### **Claim Rejections §101**

The Examiner rejected claims 52, 53, and 55-57 under 35 U.S.C. § 101 because the claimed invention are allegedly directed to a non-statutory subject matter.

Independent claim 52 satisfies the "transforms an item" branch of the test enunciated in *In re Bilski*, 88 USPQ2d 1385 (CAFC) (2008). In particular claim 52 recites "consolidating multiple of the plurality of messages into single message packages." Thus, a "plurality of messages" are transformed into "single message packages." For example, an envelope including multiple statements is created instead of multiple envelopes including separate statements. This is clearly a transformation that brings independent claim 52 within patentable subject matter. Accordingly, it is requested that these rejections of claim 52, and its dependent claims be withdrawn.

### **Claim Rejections Under 35 U.S.C. § 112**

The Examiner rejected claim 30 as being indefinite. As noted above in the Non-Entry of Amendments section, Applicants attempted to amend Claim 30 to correct the mistake in accordance with the intended understanding as articulated by the Examiner in paragraph 10 of the December 12, 2008 Office Action. Accordingly, in the interest of simplifying issues for appeal and responding to issues expressly identified by the Examiner in a prior office action, the amendment should be entered and the rejection should be withdrawn.

### **Claim Rejections §103**

#### *Rejections Over Schumacher in view of Savage*

The Examiner rejected claims 1-3, 9-17, 30-32, and 38-45 under 35 U.S.C. § 103(a) as being unpatentable over Schumacher in view of U.S. Patent 7,236,950 to Savage, et al. ("Savage").

In connection with, the Examiner stated that Schumacher does not include a system "wherein the marketing rules include a rule whether messages that include particular marketing content may be consolidated," as recited in independent claim 1. The Examiner then relies upon the Savage reference for the proposition that consolidation provides cost advantages. However, Savage fails to disclose, or to suggest, the very thing that the Examiner admits is missing from Schumacher. The claim language is directed to "rules" about whether "particular marketing content may be consolidated." Such rules may dictate that certain content may or may not be consolidated. Savage teaches nothing about such rules, and that claim language has been improperly ignored in making these rejections. Because the "rules" components of the claim have not been disclosed or suggested in either reference, no *prima facie* case of obviousness has been made.

Savage's general teaching of consolidation does not cure the deficiency of Schumacher. It is impermissible for the Examiner to simply state that it would have been obvious to create new elements that are otherwise not found in the prior art. For a *prima facie* case of obviousness, every element must be found in the prior art. This is not a case of asserting that one of ordinary skill in the art would know to tie the pieces

together, as is often argued in view of the *KSR* decision. Rather, no showing of the elements has been made. Accordingly, for at least these reasons, the rejection of claim 1 and its dependent claims 13 and 14 should be withdrawn.

Similarly claim 30 recites a step of "preventing messages from being consolidated based on the marketing rules that include a rule whether messages that include particular marketing content may be consolidated" (previously recited in claim 34). Once again *Savage* fails to cure the deficiency of *Schumacher*. Accordingly, for at least these reasons, the rejections of claims 30 and dependent claims 41 and 42 should be withdrawn.

*Rejections over Schumacher in view of Johnson*

Claims 6-8 and 35-37 were rejected over *Schumacher* in view of U.S. Publication No. 2004/0230523 to Johnson ("Johnson"). Claims 6 and 35 have been cancelled and the subject matter has been added to their depending claims 7, 8, 36, and 37 respectively. Johnson fails to cure the deficiencies identified above with regard to the *Schumacher* reference in view of the independent claims.

Further, Johnson does not teach using customer preferences to determine whether consolidation (claims 7, 36) or householding (claims 8, 37) is desired in the first place. The Examiner has asserted that Johnson teaches a preference for receiving a hardcopy document. However, this is not what is recited in the claims, so the reference fails to support a *prima facie* case of obviousness. Accordingly, the rejections of these claims should be withdrawn.

*Rejections over Schumacher in view of Stepno*

Claims 18-20, 22, 24-26, 28, 46-48, 50, 52 -54 and 56 were rejected over *Schumacher* in view of U.S. Publication No. 2002/0133472 to Stepno ("Stepno"). Since Stepno fails to cure the deficiencies of *Schumacher* with regard to independent claims 1, 24, and 30, the corresponding dependent claims should be allowable for the same reasons.

With regard to independent claim 52, the subject matter of claim 54 has now been added to that independent claim. Neither *Schumacher* nor Stepno discloses or suggests that "the step of consolidating includes determining whether a customer preference authorizes consolidation for a particular message." The Examiner cites

known concern for privacy as the motivation for this component. However, the Examiner has still failed to cite a reference that supports using a "customer preference" to authorize consolidation. While privacy a known problem, the Examiner has provided no support for concluding that such a general concept would result in the particular steps recited.

*Rejections over Schumacher in view of Stepno and Johnson*

Claims 21, 23, 27, 29, 49, 51, 55 and 57 were rejected over Schumacher in view of Stepno and further in view of Johnson. As cited by the Examiner, Johnson only describes offering discounts for making quick payments. The claims recite describing the benefits of householding or consolidation. Thus, the disclosure of Johnson is different that what is recited in the claims, so it is inadequate to serve as a teaching or disclosure of the element for purposes of making a prima facie obviousness rejection. Accordingly, the rejections of these claims should be withdrawn.

*Rejections over Schumacher alone*

Claims 31 - 33 were rejected over Schumacher. As discussed above, Schumacher fails to disclose or suggest the features recited in independent claim 30. Accordingly, these dependent claims should be allowable for the same reasons.

For these reasons it is requested that some or all pending rejections be withdrawn prior to the filing of an Appeal Brief for this patent application.

Respectfully submitted,

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